



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/581,412 06/12/00 SCHNEIDER

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HM22/0813

EXAMINER

YU, G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/581,412

Applicant(s)

SCHNEIDER ET AL.

Examiner

Gina C Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The receipt of Amendment filed on May 29, 2001, is acknowledged. Claims 1-10 are cancelled and new claims 11-40 are now pending. New grounds of rejection under 35 U.S.C. §§ 112 and 103 have been instituted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20 and 37-39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is rejected because the phrase "on the one hand and . . . on the other hand" is confusing. Claims 19, 20, and 37-39 are rejected for an analogous reason.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahms et al. (U.S. Pat. No. 5,744,062) in view of Aronson et al. (U.S. Pat. No. 4,606,913) and Kurtz et al. (SOFW J., 1997, 123(3)).

Dahms et al. disclose method to formulate oil-in-water emulsifier blends for stable oil-in-water emulsions. The compositions are formulated for cosmetic purposes, as evidenced in col. 5, lines 23 – 28; col. 7, lines 44 – 49; col. 6, lines 22 – 26; col. 8, lines 44 – 49. Thus instant claim 22 is met. The reference teaches steps to formulate

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co-emulsifiers which forms liquid crystalline gel network structure and thereby stabilizes the emulsion. See col. 1, line 6 – col. 20, line 44; Figure 6A. The references also cites well-known cosmetic coemulsifiers including glyceryl stearate citrate, sorbitan stearate, and cetearyl alcohol, which meets components (I), (II), and (III) in claims 11 and 23 and claims 21 and 40. See col. 5, line 33 – col. 6, line 27. The reference further teaches that the disclosed coemulsifiers may be used in mixture, see col. 6, line 21. The teaching of selecting coemulsifiers that are capable of forming a gel network in an aqueous phase is disclosed in col. 16, lines 44 – 47. Given the teaching of using a blend of glyceryl monostearate and cetostearyl alcohol in any ratio in col. 16, lines 48-53, examiner takes the position that the optimal amount of the emulsifier components, as required by instant claims 12-20 and 31-39, would have been discovered by routine experiments. Although the reference lacks an explicit teaching of using electrolytes and the amount of each component which may be used in the invention, it teaches using primary emulsifiers with alkali metal, alkaline earth metal, ammonium, or a substituted ammonium group having one or more C1 to C3 alkyl or hydroxyalkyl groups. See col. 6, line 28 – col. 7, line 32. It is examiner's position that these primary emulsifiers, when dissolved in aqueous solution, will be the source of electrolytes, which meets instant claims 11 and 23. Dahm et al. further teach that, in the process of the preparation of the emulsion, the amount of coemulsifier in the O/W emulsion depends on the type of the carrier, and that the choice of coemulsifier is determined by formulator preference, cost or physical properties of the coemulsifiers. See col. 9, line 41 – col. 20, line 44. The reference further teaches that the ratio of the primary emulsifier, which examiner takes

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to be the source of electrolytes, and the co-emulsifier, is balanced to achieve maximum swelling of the water gap in the liquid crystals. See col. 12, line 45 – col. 13, line 15.

Dahms lacks an explicit teaching of method to stabilize the emulsion by incorporating the electrolytes into emulsion, and the selection of the specific emulsifiers in instant claims.

Aronson et al. teaches a topical emulsion composition with electrolyte in aqueous phase. The reference further teaches that the incorporation of sufficient amount of electrolyte into the aqueous phase of the emulsion results in the improved stability of the emulsion, i.e., reduced chance of phase separation for extended periods of time. Thus claim 23 is met. The stability of the emulsions are described in detail in col. 19, lines 21 – 57. Using the emulsifier in the amount of 0.5 to 5 % by weight of the emulsion is also disclosed, See col. 8, lines 25 – 34. The conventional emulsifiers, including sorbitan isostearate (Arlacel 987), mono and diglycerides of fat forming fatty acids, is disclosed in col. 5, line 33 – col. 6, line 17. It further teaches that a skilled worker would have been able to optimize the kinds and quantity of electrolytes to be used via simple experiments, col. 8, lines 50 – 67. The electrolytes are disclosed in col. 9, line 9 – col. 10, line 10. The reference lacks the teaching of employing the specific emulsifiers of instant claims.

Kutz et al. teach selected oil-in-water emulsifiers for use in sensitive skin care products, wherein the emulsifiers include glyceryl stearate citrate, sorbitan stearate with sucrose cocoate, and cetearyl alcohol with cetearyl polyglucose. See Table 1 and summary.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Dahm et al. by adding the electrolytes into the emulsion as taught by Aronson et al., because of the expectation to successfully producing a balanced, stable cosmetic emulsion composition which is less likely to undergo phase separation and retain the stability for extended period of time. One would also have been motivated to select the emulsifiers (glyceryl stearate citrate, sorbitan stearate and cetearyl alcohol) from Dahms, as suggested by Kurtz et al., because of the expectation of successfully producing O/W emulsion composition which produces less irritation and therefore is more suitable to sensitive skin.

Response to Arguments

Applicant's arguments have been fully considered but they are moot in part and unpersuasive in part.

(1) Applicants' argument that the obviousness rejection over Dahms is deficient because the reference lacks teaching, suggestion, or motivation to combine the all four components should be selected or combined, is moot in view of the new grounds of rejection as stated above.

(2) Applicants argue that the Dahms lacks a mention of its usefulness for skin care. Examiner respectfully disagrees. The reference clearly teaches that the emulsions are tested based on the mildness to skin, as in col. 5, lines 22 - 28. The use of the composition is for cosmetic purposes is also evident from the fact that Dahms incorporates a reference commonly used in cosmetic art, as cited in col. 6, lines 22 –

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26. One skilled in the art would have readily known that the teaching of Dahms is useful to the field of skin care.

(3) Applicants' argument that Dahms lacks the teaching of the effect of the addition of electrolytes to the emulsion is moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
August 8, 2001